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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,058	04/19/2004	Masao Ishida	SAEG166.001AUS	2296
20995 7590 02/06/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER NGUYEN, CAM N	
			ART UNIT 1754	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/06/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/06/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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## Office Action Summary

Application No.

10/827,058

Applicant(s)

ISHIDA ET AL.

Examiner

Cam N. Nguyen

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/17/06 (an election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on originally filed is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/19/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Response to Election/Restrictions

1. Applicant's election without traverse of Group II, Claims 5-11, in the reply filed on November 17, 2006 is acknowledged.

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2. Claims 1-4 & 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Election was made without traverse in the reply filed on November 17, 2006.

### Claim Objections

3. Claims 5-11 are objected to because of the following informalities:
  - A. In claims 5-9, the claims are depending upon nonelected claims 1-4. The subject matter of claims 1-4 must be incorporated into the elected claims 5-9 for examination.
  - B. In claims 5-9, line 1, "the" should be changed to --an--.
  - C. In claim 10, line 1, "any of" should be changed to --anyone of--.
  - D. In claim 11, line 2, "obtained" should be changed to --prepared--.
  - E. In claim 11, line 2, "any of" should be changed to --anyone of--.Appropriate correction is required.

### Claim Rejections - 35 USC § 112 (Second Paragraph)

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 5-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Regarding claims 5-9, the claim recites "reacting a calcium silicate and a copper salt together", but it does not set forth whether this reacting step is forming a mixture of the two compounds or solution, etc. Thus, renders the claim vague and indefinite.

B. Claims 8 & 9 recite the limitation "acid treatment" in line 6. There is insufficient antecedent basis for this limitation in the claim.

**Claim Rejections - 35 USC § 102(b)**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheung et al., "hereinafter referred to as Cheung, (US Pat. 5,106,810).

Cheung discloses composition comprising a nonfused methanol dissociation catalyst of 20 to 99.9 weight percent copper and 0.1 to 10 weight percent amorphous silica (see col. 6, claim 1). The catalyst further comprising one or more metals selected from the group consisting of metals including calcium (see col. 6, claim 3). At col. 3, ln 14- 35, Cheung broadly discloses that the disclosed catalyst is prepared by adding an aqueous solution of appropriate metal salts slowly with vigorous stirring to silica dispersed in an aqueous solution of sodium carbonate.

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After the precipitation and mixing are complete, the slurry is filtered to remove excess liquid and then washed with warm water to remove the by-products of the precipitation process, etc. the resulting catalyst precursor is calcining to convert the various metal salts to their respective metal oxides. Suitable sources of the transition metals include nitrates, acetates, oxalates and carbonates, etc. (see col. 3, ln 35-41).

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There is no patentable distinction seen between the claimed catalyst and process of making, and those disclosed by Cheung. Thus, the claims are anticipated by the teaching of the reference.

#### Citations

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared attached.

#### Conclusion

9. Claims 1-12 are pending. Claims 5-11 are rejected. Claims 1-4 & 12 are withdrawn due to nonelected (distinct) invention(s). No claims are allowed.

#### Contacts

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application-Information-Retrieval-(PAIR)-system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Nguyen/cnn

Primary Examiner

January 30, 2007

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